

### **REMARKS**

In the Office Action mailed February 24, 2004, claims 3-6, 8-11, 13-14, 16-17, 19, 24-34 and 37-38 were withdrawn from consideration as being drawn to a nonelected invention. Claims 37-40 were renumbered 36-39. Claims 1, 36 and 37 were rejected under 35 U.S.C. 112, second paragraph. Claims 1-2, 7, 12, 18, 20-23, 35-36 and 38 were rejected under 35 U.S.C. 102(e). Claims 1-2, 7, 12, 18, 20-21 and 39 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Claim 15 was said to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph.

#### **Election/Restriction**

In the Office Action mailed February 24, 2004, the elected species MDW 1401 was said to be allowable over the prior art. The Office Action stated a search was performed for a compound having a phenylpyrimidinyl core with an oxygen-containing three membered-ring. This compound was said to read on claims 1-2, 7, 12, 15, 18, 20-23, 35-36 and 39. Claims 3-6, 8-11, 13-14, 16-17, 19, 24-34 and 37-38 were withdrawn from consideration as being drawn to a nonelected invention. In response, it is noted that claim 8 reads on the originally elected species and should be included in the claims under consideration. Claim 9 also contains an oxygen-containing five-membered ring and should be included in the claims under consideration. In addition, it is believed claim 24 should be included in the claims under consideration because it provides a concentration limitation to a claim under consideration (claim 23). New claim 40 should also be included in the claims under consideration because it reads on the elected species. New claim 40 is supported by the specification on page 4 and page 3, last paragraph. New compound claim 41 has been added which reads on the elected species and is supported by the specification as filed on page 3, last paragraph and page 6, last paragraph. New composition claim 42 has been added which depends from claim 40 and which reads on the elected species. No new matter is added by any amendment or new claim.

### Claim Objections

In the Office Action mailed February 24, 2004, the numbering of claims was objected to as not in accordance with 37 C.F.R. 1.126. The Office Action stated claims 37-40 were renumbered 36-39. It is noted that there is no claim 14. To comply with 37 C.F.R. 1.126, which states "the original numbering of the claims must be preserved throughout the prosecution", a claim number 14 is included with the parenthetical expression (canceled).

### 35 U.S.C. 112, rejection of claims 1, 36 and 39

In the Office Action mailed February 24, 2004, claims 1, 36 and 39 were rejected under 35 U.S.C. 112, second paragraph.

The word "halide" in the notation W in claim 1 was said to be vague. In response, the word "halide" in the notation W in claim 1 has been replaced with "halogen" as helpfully suggested by the Examiner. This amendment to claim 1 is supported by the specification as filed, including the structures in Scheme 1.

The dependency of claim 36 was said to be improper because claim 36 depended from claim 36. In response, claim 36 has been amended to depend from claim 35.

In claim 39 (original claim 40), the language "comprising one or more compounds of claim 1" was said to be vague. In response, renumbered claim 39 has been amended to clarify the optical device comprises one or more chiral, non-racemic compound of claim 1. This amendment to claim 39 is supported by claim 1.

35 U.S.C. 102 rejection

In the Office Action mailed February 24, 2004, claims 1-2, 7, 12, 18, 20-23, 35-36 and 38 were rejected under 35 U.S.C. 102(e) over Gough et al. (US 2002/0195,585). The cited reference is a publication of US application 09/754,034, now US Patent 6,759,101.

The Office Action cited MX 9454 in Table 15 on page 40 and the liquid crystal properties in Table 1 on page 18. Component 1139 of mixture MX 9454 reads on claim 1 of the present application.

In response, a Declaration of the inventors of the current application is attached which states compound 1139 of mixture MX 9454 was invented by the inventors of the current application. Both the current application and 09/754,034 are assigned to Displaytech, Inc. All inventors of the respective applications worked for Displaytech, Inc. at the time the inventions were made. In addition, the priority provisional application for the above-referenced application was referenced in US patent 6,759,101 in column 13, lines 36-38. The disclosure cited by the Examiner in the Office Action is the work of the applicants of the current application.

In view of the above, it is believed the rejection is overcome. Reconsideration and withdrawal of the rejection is respectfully requested.

Double Patenting Rejection

In the Office Action mailed February 24, 2004, claims 1-2, 7, 12, 18, 20-21 and 39 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1, 17 and 19 of copending application 09/754,034. Application 09/754,034 is now US Patent 6,759,101.

In response, although Applicants do not concede to the rejection, to advance prosecution, a terminal disclaimer is attached hereto.

In view of the above, it is believed this rejection is overcome. Reconsideration and withdrawal of the rejection is respectfully requested.

Allowable subject matter

In the Office Action mailed February 24, 2004, claim 15 was said to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph and to include all of the limitations of the base claim and any intervening claims.

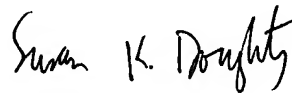
In response, in view of the above arguments and amendments, it is believed claim 15 is allowable.

CONCLUSION

In view of the above arguments and amendments, it is believed the claims are allowable. Reconsideration and withdrawal of all rejections and objections is respectfully requested. If there are any issues remaining to patentability, the Examiner is respectfully requested to telephone the undersigned.

This response is accompanied by a petition for a three month extension of time and fee (\$950); a terminal disclaimer and fee (\$110) and the fees for two independent claims and one dependent claim (\$190). If the fees submitted are incorrect, however, please deduct the appropriate amount or credit any overpayment to Deposit Account 07-1969.

Respectfully submitted,



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